

## **REMARKS/ARGUMENTS**

Reconsideration of this application is requested. Claims 1, 9, 10, 18-29 are in the case.

### **I. ELECTION/RESTRICTION**

Election of Group II (claims 1-29) is hereby acknowledged. The deletion of subject matter in the present amendment is effected without prejudice to pursuing the cancelled subject matter in one or more separate divisional applications.

### **II. INFORMATION DISCLOSURE STATEMENT**

The Examiner here has questioned the four B-Door External citations listed in the PTO-1449 and submitted in the parent application. Those references are re-presented herewith for the Examiner's consideration and entry into the record.

### **III. SPECIFICATION**

The title has been objected to as allegedly not descriptive. In response, the Examiner's suggested title has been adopted.

The specification has been corrected to remove obvious typographical errors and to improve the form as suggested by the Examiner on page 3 of the Action. No new matter is entered.

**IV. CLAIM OBJECTIONS**

Claims 10 and 21 have been objected to as reciting a non-elected invention. In response, claims 10 and 21 have been amended without prejudice to remove the non-elected subject matter. Withdrawal of these objections is now respectfully requested.

**V. THE 35 U.S.C. §101 REJECTION**

Claims 1-6 stands rejected under 35 U.S.C. §101 as allegedly reading on non-statutory subject matter. In response, claim 1 has been clarified to recite "an isolated and purified polynucleotide. Claims 2-6 have been cancelled without prejudice. Withdrawal of this rejection is now respectfully requested.

**VI. THE 35 U.S.C. §102 REJECTION**

Claims 1-6 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Hunt et al. That rejection is respectfully traversed.

Without conceding to the merit of the rejection, and in order to expedite prosecution, claim 1 has been amended to incorporate the subject matter of original claim 7 which is not rejected under 35 U.S.C. §102(b). Claims 2-6 have been cancelled without prejudice, as noted earlier. In light of this amendment, it is believed that claim 1 is not anticipated by Hunt et al. Reconsideration and withdrawal of the anticipation rejection are accordingly respectfully requested.

**VII. THE 35 U.S.C. §112, FIRST PARAGRAPH, REJECTION**

Claims 1-6, 8, 9, 11-18, 20 and 22-28 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter which was not described in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

The specification at page 2 contains a written description with respect to yeast promoter fragments containing at least 17 contiguous nucleotides of a polynucleotide, and the polynucleotides are shown in SEQ ID NOS:1-4. Further description appears at page 8 where yeast promoters are described comprising at least 17-700 contiguous nucleic acids of the isolated and purified polynucleotide up to the maximum length provided in any one of the sequences SEQ ID NOS:1-4. At page 10 of the specification, a description is provided of how promoter activity may be determined with respect to the promoters and promoter fragments. Given the detailed content of the specification, taken with the level of ordinary skill in this art, it is believed that the skilled artisan would not conclude that, as of the time of filing of the present application, the inventors did not have possession of the claimed invention. The Examiner's position in this regard therefore is believed to be incorrect.

In order to expedite prosecution to a favorable conclusion, the claims have been amended so that they now do not refer to the nucleotide fragments of SEQ ID NO:2.

Reconsideration and withdrawal of the outstanding 35 U.S.C. §112, first paragraph, rejection are accordingly respectfully requested.

**VIII. THE 35 U.S.C. §112, SECOND PARAGRAPH**

Claim 7 stands rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. In response, and without conceding to the merit of this rejection, claim 7 has been cancelled without prejudice.

For consistency, claim 29 has been amended in Step (a) to refer to contiguous nucleotides of an isolated and purified polynucleotide consisting of SEQ ID NO:2. No new matter is entered.

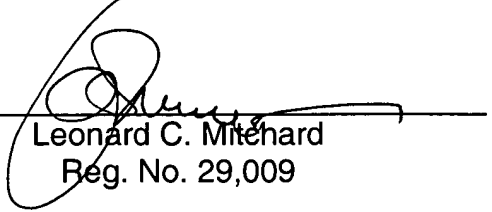
Withdrawal of the outstanding 35 U.S.C. §112, second paragraph, rejection is now believed to be in order. Such action is respectfully requested.

Favorable action on this application is awaited.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_

  
Leonard C. Mitchard  
Reg. No. 29,009

LCM:lfm  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100  
Attachments: Four references